



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,671	09/23/2003	Hiroshi Takei	242831US0	9100
22850	7590	06/05/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
ZIMMER, MARC S				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
06/05/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

10/667,671

Applicant(s)

TAKEI ET AL.

Examiner

MARC S. ZIMMER

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 13-19 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-8 and 13-19 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 and 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okami et al., U.S. Patent # 6,074,963 in view of any one or more of Stein et al., U.S. Patent # 5,567,752, Ching, U.S. Patent # 4,368,241, Putzer et al., WO 02/062897, Fujioika et al., U.S. Patent # 6,127,503, and Fujiki et al., U.S. Patent # 5,792,812.

Applicants continue to challenge the Examiner's contention that the claims are unpatentable on the grounds that there is no evidence given in support of his assertion that organosilicon compounds featuring one or more of the functional groups outlined under the description of component (d) are widely recognized as the adhesion promoters of choice for bonding curable silicone compositions that cure by any of the three main mechanisms, i.e. hydrosilylation/addition curing, free radical curing, and condensation curing to a multitude of different surfaces that includes thermoplastic films/sheets. In an earlier correspondence, the Examiner emphasized the following regarding the proper selection of an adhesion promoter:

"...the recognized role of an adhesion promoter is to do just that, promote/facilitate adhesion between the polymer matrix and a substrate. It does so by creating formal covalent chemical bonds between available chemical moieties on the substrate and available chemical moieties within the polymer. That is to say, the adhesion promoter contains at least one group that is chemically complimentary to a group found in the polymer matrix and a second group that is chemically complimentary with groups found at the surface of the substrate. Insofar as the prior art polysiloxane is peroxide/hydrosilylation curable, vinyl groups and SiH groups are obvious of substituents that an adhesion promoter could be outfitted with to create bonds with the host polymer."

The Examiner acknowledges, nevertheless, that his position has never been augmented with prior art teachings. Each of the supporting references was chosen because it disclosed not only the intent to prepare integrally bonded articles comprising a layer made up of a comparable crosslinkable polysiloxane and a layer of thermoplastic, but also that the adhesion of said layers is promoted by an organosilicon compound featuring the same attributes as are the claimed adhesion promoters.

It will first be reiterated that, although Okami does not expressly disclose the employment of an adhesion promoter, the Examiner is adamant that the insertion of an adhesion promoter to facilitate a more robust bonding interaction between layers would have been obvious insofar as it is well documented that silicone rubbers easily peel away from thermoplastic materials. Because Okami does not teach what are the adhesion promoters known to assist in creating better adhesion between the layers, the skilled artisan would turn to the related prior art to determine what compounds may be used to fulfill this role. Each of the aforementioned references discloses one or more permutations of the claimed adhesion promoter and, in fact, Putzer (pages 4 and 5) and Fujiki (which, not insignificantly, is assigned to the same assignee as is Okami) both describe adhesion promoters corresponding to the particular adhesion promoters contemplated in claim 19.

As to the notion that Applicant has now proven that the added limitation that the intermediate layer is non-porous is supported by the original disclosure, the Examiner has several concerns. First, Applicants admit that there are several products under the TEONEX brand and only now are they saying that one of these in particular, TEONEX

Q51, was used in their experiments. If any of the other films under the TEONEX name are, in fact, porous, than this might represent an issue of some significance since the original disclosure identified the film only as a TEONEX film. Next, the plastic film examined in the 132 Declaration is sputtered prior to having been viewed through a scanning electronic microscope. There is no indication that the intermediate plastic film disclosed in Example 3 of the specification has been subjected to a similar treatment and the Examiner is unclear as to how this would impact the porosity of the film. If it is necessary for the film to undergo sputtering in order to make it non-porous, a point about which the Examiner is unclear, and the Specification has not mentioned a sputtering step, than the Examiner logically would be forced to assume that the intermediate film disclosed in the Specification is not non-porous. As to the probative value of the SEM photographs, the reproductions are quite poor and, in any case, the Examiner is unsure what they are supposed to show. Applicant is requested to (i) provide better reproductions and/or originals if possible, and (ii) describe to the Examiner how precisely they prove the non-porous nature of the film. Applicant must explain to the Examiner how the SEM photographs unequivocally demonstrate that the plastic film being visualized is not porous by any measure including being impermeable to gases.

Of course, Applicant could always consider filing a CIP so as to add the recitation that the intermediate film is non-porous. An accompanying definition of non-porous would also be regarded as quite important.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC S. ZIMMER whose telephone number is (571)272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

May 31, 2008

/Marc S. Zimmer/
Primary Examiner, Art Unit 1796